

REMARKS

Claims 1 to 8 and 28 to 40 are pending in the application, with claims 9 to 27 having been previously cancelled and claims 29 to 40 having been previously added. Claims 1, 8 and 28 are independent. Favorable reconsideration and further examination are respectfully requested.

In the Office Action, the claims were rejected under 35 U.S.C. §101 for allegedly failing to comply with the utility requirement. In particular, it was said in the Office Action that "the claim must recite more than 101 judicial exception, in that the process claim must set forth a practical application of that judicial exception to produced a real-world result". It was further said that the claims are missing a practical application and, therefore, the claims do not meet the utility requirement. Applicants respectfully disagree. As explained in the enclosed memorandum from John J. Love, Deputy Commissioner For Patent Examination Policy,

A practical application in this context can be the result itself, and does not require that steps or additional limitations be added to the claims...It is the result that should be the focus. If the result has a real world practical application/use, then the test has been satisfied. *The claim need not include the uses to which the result is ultimately put, just the result itself.* (emphasis added)

In this case, each of the independent claims generates a teaser that corresponds to a query, and outputs the teaser. The teaser has practical application in that it may be used to suggest additional searches or subject matter for the user based on an input query. Thus, the output result of the claims has a real world practical application/use, therefore, the test for practical applicability has been satisfied according to the Deputy Commissioner.

Regarding claim 8, the Office Action also states that claim 8 is functional descriptive material per se and, therefore, not patentable. Applicants respectfully disagree and direct the Examiner to In re Beauregard¹, a copy of which is enclosed. In that case, which was before the Federal Circuit, the Commissioner explicitly sanctioned computer program claims that were characterized as a computer program embodied in a tangible medium (in the case of claim 8, executable instructions in machine-readable memory). The Commissioner also agreed that the printed matter doctrine is inapplicable to such claims. There is no requirement in In re Beauregard for the program "to be executed directly or positively", as indicated in the Office Action.² As explained above, the invention of claim 8 also has a real world practical application/use. Therefore, claim 8 is believed to comply fully with §101.

Next, the Office Action states that there is no support for the feature of "machine-readable memory" in claims 8 and 35 to 40. Applicant respectfully directs the Examiner to page 5, lines 22 et seq. of the specification, in particular to memory 32, which stores instructions 36 that are executed to perform processes 50 and 100. Applicant respectfully reminds that Examiner that features of a claim need not be present verbatim in the specification. In this case, it is clear that memory 32 is readable, e.g., by processor 30 (a machine) to perform the processes (otherwise, how would processor 30 obtain the instructions), and that one of ordinary skill in the art would understand that memory 32 is machine-readable in this way. Accordingly, Applicant submits that there is clear support in the specification for "machine-readable memory". Accordingly, withdrawal of the §112 rejection of claims 8 and 35 to 40 is respectfully requested.

¹ 53 F.3d 1583 (Fed. Cir. 1995)

² Office Action, page 4

It is believed that all of the pending claims have been addressed. However, the absence of a reply to a specific rejection, issue or comment does not signify agreement with or concession of that rejection, issue or comment. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment.

In view of the foregoing amendments and remarks, Applicant respectfully submits that the application is in condition for allowance, and such action is respectfully requested at the Examiner's earliest convenience.

Applicant's undersigned attorney can be reached at the address shown below. All telephone calls should be directed to the undersigned at 617-521-7896.

Please apply any fees or credits due in this case, including claims fees, to Deposit Account No. 06-105 referencing 10984-601001.

Applicant : Andrew R. Golding
Serial No. : 09/927,015
Filed : August 9, 2001
Page : 12 of 12

Attorney's Docket No.: 10984-601001
Client Ref.: P-272

Respectfully submitted,

Date: July 9, 2007 (Monday)



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United States Court of Appeals,
Federal Circuit.

In re Gary M. BEAUREGARD, Larry K. Loucks,
Khoa Dang Nguyen and Robert J.
Urquhart.
No. 95-1054.

May 12, 1995.

Appeal was taken from order of the Board of Patent Appeals and Interferences rejecting computer program product claims on basis of printed matter doctrine. On Commissioner's motion to dismiss appeal, the Court of Appeals, Archer, Chief Judge, held that appeal did not present case or controversy, where parties agreed that printed matter doctrine did not apply to computer program product claims.

Vacated and remanded.

West Headnotes

Patents ↪ 324.2

291k124.2 Most Cited Cases

Appeal from decision of the Board of Patent Appeals and Interferences, rejecting computer program product claims on basis of printed matter doctrine, did not present case or controversy, where parties agreed that printed matter doctrine did not apply, and Commissioner of Patents and Trademarks stated that computer programs embodied in tangible medium, such as floppy diskettes, were patentable. 35 U.S.C. §§ 101-103.

*1583 Nancy J. Link, Sol., Albin F. Drost, Deputy Sol. and Richard Torozon, Associate Sol., Office of the Sol., Arlington, VA, were on the Com'r of Patents and Trademarks motion to dismiss for lack of jurisdiction.

Robert Greene Sterne, Sterne, Kessler, Goldstein & Fox, Washington, DC, was on Appellants' response to the Com'r's motion to dismiss for lack of jurisdiction.

ON MOTION
ORDER

ARCHER, Chief Judge:

The Commissioner of Patents and Trademarks moves to dismiss Gary M. Beauregard *1584 et al.'s appeal. Beauregard responds stating that vacatur or reversal of the Board of Patent Appeals and Interferences' decision and remand to the Board is the appropriate disposition. Beauregard requests that the remand order be issued as a precedential order.

Briefly, on August 4, 1994, the Board rejected Beauregard's computer program product claims on the basis of the printed matter doctrine. Beauregard appealed. The Commissioner now states "that computer programs embodied in a tangible medium, such as floppy diskettes, are patentable subject matter under 35 U.S.C. § 101 and must be examined under 35 U.S.C. §§ 102 and 103." The Commissioner states that he agrees with Beauregard's position on appeal that the printed matter doctrine is not applicable. Thus, the parties are in agreement that no case or controversy presently exists.

Accordingly,

IT IS ORDERED THAT:

The Board's decision is vacated and the case is remanded for further proceedings in accordance with the Commissioner's concessions.

53 F.3d 1583, 35 U.S.P.Q.2d 1383

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UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
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MEMORANDUM

DATE: April 12, 2007
TO: Technology Center Directors
FROM: John J. Love *HL*
Deputy Commissioner
For Patent Examination Policy

SUBJECT: Clarification of Interim Guidelines For Examination of Patent Applications
for Subject Matter Eligibility

Certain inconsistencies have come to my attention in the application of the Interim Guidelines For Examination of Patent Applications for Subject Matter Eligibility, which are set forth in section 2106 of the Manual of Patent Examining Procedure (8th Ed. Rev. 5, Aug. 2006) (MPEP). The situation arises in the context of whether or not a claim is for a practical application of an abstract idea, law of nature, or natural phenomenon. As stated in the Interim Guidelines, a claim is for a practical application of an abstract idea, law of nature, or natural phenomenon when the claimed invention "transforms" an article or physical object to a different state or thing, or when the claimed invention produces a useful, concrete and tangible result. See MPEP 2106, subsection IV.C.2.

Focus on Result

A practical application in this context can be the result itself, and does not require that steps or additional limitations be added to the claim. As stated in *State Street Bank & Trust Co. v. Signature Financial Group, Inc.*, 149 F.3d 1368, 1373, 47 USPQ2d 1596, 1601 (Fed. Cir. 1998):

Today, we hold that the transformation of data, representing discrete dollar amounts, by a machine through a series of mathematical calculations into a final share price, constitutes a practical application of a mathematical algorithm, formula, or calculation, because it produces "a useful, concrete and tangible result"—a final share price momentarily fixed for recording and reporting purposes and even accepted and relied upon by regulatory authorities and in subsequent trades.

It is the result that should be the focus. If the result has a real world practical application/use, then the test has been satisfied. The claim need not include the uses to which the result is ultimately put, just the result itself. Another example would be an improved method for measuring blood sugar levels in human beings. In this example, the end result is the blood sugar level which is a practical application for diagnostic purposes. Accordingly, reciting the improved method, and the result it achieves—the measurement of the blood sugar level—is all that is necessary for patent-eligibility. The diagnostic steps that occur after the determination of the blood sugar level need not necessarily be present in the claims in order for the claims to be statutory.

Use of Specific Terminology

Another area of inconsistency surrounds the use of the terms such as "determining," "calculating," and similar expressions. Some object to these as not creating a tangible result. Such terms may in fact be sufficient to establish a tangible result. See, e.g., *State Street*, 149 F.3d at 1375, 47 USPQ2d at 1602 (holding the calculation of a number having a real world value and to be a "useful, concrete, and tangible result") and *AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352, 50 USPQ2d 1447 (Fed. Cir. 1999) (holding a method claim including the generation of a message record for an interexchange call to be statutory). The specification should be referred to for a meaning of the terms. See *In re Musgrave*, 431 F.2d 882, 893, 167 USPQ 280, 289 (CCPA 1970) ("[w]e cannot agree with the board that these claims (all the steps of which can be carried out by the disclosed apparatus) are directed to non-statutory processes merely because some or all the steps therein can also be carried out in or with the aid of the human mind or because it may be necessary for one performing the processes to think. . . .").